

Appl. No. 10/052,296
Any. Docket No. G-263M (CP-1222)
Amdt. Dated February 5th, 2004
Reply to Office Action of October 14th, 2003
Customer No. 27752

REMARKS

Claims 1-6 remain pending in the present application. Claims 7-23 have been canceled. New Claims 24-29 have been added. Support for the subject matter of new Claims 24-29 may be found in the original claims, on page 5 of the specification setting forth a number of compounds of the present invention and throughout the specification in general. No new matter has been added. No additional Claim fee is due.

Claims 1-3 has been rejected under 35 U.S.C. §102(b) as being unpatentable over Bugaut, U.S. Patent No. 4,888,025.

Bugaut et al set forth substituted hydroxypropyl substituted phenol compounds which includes several substituents which potentially overlap with Applicants claimed invention. In response thereto, Applicants have amended the claimed invention such that overlapping subject matter has been eliminated. As such Applicants, claimed invention is novel over the compositions set forth in Bugaut et al.

Claims 4-6 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bugaut et al. It is the contention of the Examiner that while Bugaut does not disclose the claimed compounds as set forth in Claims 4-6, that it would have been obvious to one of ordinary skill in the art to formulate a compound having the formula recited in the claims with a reasonable expectation of success and similar results to the disclosed compounds because of the broad teaching of Bugaut et al. Applicants respectfully traverse the rejection.

Claims 1-6 as now amended and new Claims 24-29 fail to claim any of the compounds set forth in the Bugaut et al reference. While Bugaut et al may set forth a very broad teaching of compounds, the potential number of available materials is staggering. In order to establish a prima facie case of obviousness there must be some teaching or evidence to provide motivation to adjust the large number of variables necessary in Bugaut et al to arrive at Applicants claimed compounds.

Such motivation or teaching to modify the teachings of Bugaut simply does not exist. The Examiner points to the sole structure exemplified in the Bugaut reference which appears structurally similar to a portion of Applicants claimed invention. That compound, 2-hydroxy-3-(2,4-diaminophenoxy)-propyltrimethylammonium chloride hemihydrate, requires the selection of no less than 7 different variables to arrive at the structurally similar material. The Examiner contends that this similarity provides a reasonable expectation of success and similar results sufficient to modify and arrive at Applicants claimed invention. However, the compounds set forth in Bugaut are clearly intended for use in oxidation hair dye compositions. Generally, the art

Appl. No. 10/052,296
Atty. Docket No. G-263M (CP-1222)
Amdt. Dated February 5th, 2004
Reply to Office Action of October 14th, 2003
Customer No. 27752

of designing and developing dye materials for fibers is a highly unpredictable field. As such, most any modification of substituents may significantly alter the resultant performance of the dye compound. The color produced, the depth of the resultant color, the toxicity and the strength of the bond to the hair may all be materially affected by a substituent change on a molecule. Even the modification of a single methyl group may produce dramatic differences in resultant color and performance. Clearly, there can be no expectation of success in the modification of whole substituent's on dye molecules and to attempt to do so is a clear obvious to try standard.

Furthermore, the only compounds set forth by Bugaut et al in which A in Bugaut's structure is selected as N(Y)(Y')X as necessary to be similar to Applicants claimed compounds employ the C₁ or methyl substituent and chlorine as X. Accordingly, Bugaut et al establish a pattern of specific preference for compounds substituted only with methyl groups and chlorine as the associated salt. Therefore, Applicants claimed compounds of Claim 1 requiring a salt other than chlorine and Claim 27 wherein at least one substituent must be a C₂ substituent would not necessarily be envisaged by one of ordinary skill in the art as having similar properties due to the established pattern of preference for the C₁ group established by Bugaut.

Lastly, Bugaut et al fail to set forth any structurally similar compounds in which hydroxyalkyl groups are required elements as set forth in Claim 24. Clearly, without such structural similarity no evidence of reasonable success may even be proffered by the Examiner based on the teachings of Bugaut et al and such claims by Applicants are novel and unobvious.

Accordingly, Claims 1-6 and 24-29 are novel and unobvious over the prior art of record or any combination thereof.

Conclusion

In light of the remarks presented herein, Applicants' respectfully submit that Claims 1-6 and 24-29 are allowable over the prior art of record or any combination thereof. Reconsideration and reexamination are respectfully requested. In the event that issues remain prior to allowance of the noted claims, then the Examiner is invited to call Applicants' undersigned attorney to discuss any remaining issues.

Respectfully submitted,
Mu'III Lim et al

By _____
Brian M. Bolam
Attorney for Applicant(s)
Registration No. 37,513
(513) 626-4756

February 5th, 2004
Customer No. 27752